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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,597	12/19/2001	Yuji Suzuki	45939/VGG/H320	1261

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CHRISTIE, PARKER & HALE, LLP  
350 WEST COLORADO BOULEVARD  
SUITE 500  
PASADENA, CA 91105

EXAMINER

LOCKER, HOWARD J

ART UNIT PAPER NUMBER

1661

DATE MAILED: 03/21/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.



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DATE MAILED:

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 12/19/01

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire Three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ ~~Claim(s)~~ The claim is ~~is/are~~ pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ ~~Claim(s)~~ The claim is ~~is/are~~ rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

BEST AVAILABLE COPY

10/027597  
PTOL-326 (Rev. 10/95)

- SEE OFFICE ACTION ON THE FOLLOWING PAGES -

1. The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention."

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

"The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted."

The disclosure is objected to under 37 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se, and which distinguish same over related or similar known cultivars and antecedents.

More specifically:

A. The origin of the instant plant must be more correctly accounted for. Presently, applicant's specification states that such constitutes an entire species rather than a single, unnamed and unpatented plant within said species. If such is indeed the case, the specification should so state. If, upon review such is found not to be the case, the specification should provide appropriate and correct information relative to this issue.

B. As the plant is a shrub, information should be imported into the specification as to the age of the plant described at pages 4 and on of the specification. As applicant acknowledges that the plant becomes "spreading with age" (page 4, lines 23-24), it is apparent that the plant has indeed been systematically observed for at least more than one growing season. Additionally, applicant states at page 5 of the specification that the "following color readings are of specimens grown in... 2 year old specimen in 5 gallon containers", but does not state the age of the plant as otherwise described in the specification.

C. Applicant must confirm on the record that the stated location of discovery was indeed a cultivated area.

D. From the botanical information presented, it would appear that leaf length, leaf width, and overall leaf size of the instant plant is substantially larger than that of the species. If, upon review such is found to be the case, applicant should so indicate in the specification so as to further distinguish the instant plant from the species on the record.

E. If additional information is now available relative to characteristic number of petals, such should be imported into the specification in the interest of providing as complete a botanical description of the plant as is reasonably possible.

F. The designation currently set forth for petal ground color is not in the yellow-orange RHS Group, and does not reasonably correspond to the plant as illustrated, or to the generic color designation of cream as set forth in the specification. Correction and/or clarification is necessary.

G. Sepal coloration should be accounted for in the specification, as should the coloration and extent of any variegation thereon.

H. Characterization of pollen amount as "numerous" is not understood.

I. RHS 11B is not in the yellow orange group as is set forth numerous times on page 8 of the specification. Rather, such is in the yellow group.

J. Hardiness of the instant plant as set forth in the specification would appear to be greater than that of the species. If, upon review, such is found to be the case, this should be accounted for in the specification as a distinguishing feature of the plant.

The above listing may not be comprehensive. Applicant should carefully review the disclosure and import into same any additional or corrected information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is being sought.

2. The claim is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant, for the reasons set forth in paragraph 1 above.

3. Applicant is advised of the new optional procedures for amending the specification and claim under 37 CFR 1.121. The new procedures are optional until July, 2003, and such may become mandatory at that time. Applicant may review same on the internet at the following site:  
<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>

4. Any inquiry concerning this communication from the examiner should be directed to Examiner Howard J. Locker whose telephone number is 703-308-2924, and whose normal work hours are Monday through Thursday, from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Bruce Campell, can be reached at 703-308-4205.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Serial No. 10/027597

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Art Unit 1661

## **TELECOPY/FACSIMILE TRANSMISSION**

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to this Group via the PTO Fax Center in Crystal Mall 1 (CM 1). The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM 1 Fax Center number is 703-308-4556 or 703-305-3592.

Howard J. Locker/hjl

March 14, 2003

  
HOWARD J. LOCKER  
EXAMINER  
GROUP ART UNIT 1661